



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Hayes, et al.	)	Examiner:	Zimmerman
		)		
Application No.:	10/662,263	)	Art Unit:	2635
		)		
Filing Date:	September 15, 2003	)	Attny Doc.:	81230.38US5
		)		
Title:	Universal Remote Control	)		
	System	)		

APPEAL BRIEF

Mail Stop Appeal Briefs - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Appellants hereby appeal to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims 1-10 which rejection was set forth in the final Office Action mailed September 15, 2005. A timely Notice of Appeal was filed.

This Appeal Brief is being filed in triplicate.

The Commissioner is hereby authorized to charge any fee deficiency or credit overpayment to deposit account number 50-2428 in the name of Greenberg Traurig.

01/18/2006 BABRAHA1 00000054 10662263

01 FC:1402 500.00 0P

Certificate of Mailing: I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail, postage prepaid, in an envelope addressed to: Mail Stop Appeal Briefs - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 12th day of January, 2006

By: 

Vivian DeLaRosa

I. Real Party In Interest

The real party in interest is Universal Electronic Inc.

II. Related Appeals And Interferences

It is not believed that any appeals or interferences are pending which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status Of The Claims

In the application, claims 1-10 remain pending and, having been finally rejected, are the subject of this appeal.

Claims 11-19 were canceled during the course of prosecution.

The attached Appendix provides a clean, double spaced copy of pending claims 1-10.

IV. Status Of Amendments

The claims are in condition for appeal – no further amendments to the claims are pending.

V. Summary Of The Claimed Subject Matter

With general reference to Paragraph 0047 and the Figures of the published application for patent (US 2004/0056984), the subject matter defined in the independent claim is a system for programming a remote control (11) using a readable media or smart card (15). The readable media (15) has stored thereon code data. The code data is readable by the remote control (11) for use by the remote control (11) in connection with commanding a first home appliance to perform an operation. In addition, the readable media (15) has stored thereon access data. The access data is modifiable by the remote control (11) for the purpose of limiting the ability of a remote control to use the code data.

## VI. Grounds Of Rejection To Be Reviewed On Appeal

1. Whether the rejection of independent claim 1 under 35 U.S.C. § 103 can be maintained when the references being relied upon, whether considered alone or in combination, fail to include each and every element set forth in the claims and, furthermore, fail to have any disclosure that would suggest the desirability of modifying the primary reference to arrive at the invention set forth in the claim.

2. Whether the rejection of independent claim 1 under 35 U.S.C. § 103 can be maintained when the rejection of the claim is based upon art that is “non-analogous.”

3. Whether the rejection of any of dependent claims 2-10 under 35 U.S.C. § 103 can be maintained when the rejection of the claims fails to assert or allege that any of the elements set forth within the dependent claims are found in the prior art.

## VII. Argument

### A) Summary of the outstanding rejections of the claims

The pending claims stand rejected under 35 U.S.C. § 103 as being rendered obvious based upon the combination of Pariente (WO 9409570) and Renner (U.S. Patent No. 5,679,945).

In rejecting the claims, it was asserted that Pariente discloses a remote controller that includes a readable media storage device where the readable media storage device includes code data for commanding different electronic devices. It was acknowledged that Pariente fails to disclose that the readable media storage device includes access data for limiting use of the code data. Nevertheless, it was asserted that Renner teaches an intelligent card reader which, to

prevent unauthorized use of a smart card, is programmed with limitations such as the number of times the card can be used or having preprogrammed expiration dates. It was therefore concluded that “it would have been obvious to one of ordinary skill in the art at the time of the invention to have used an operation limitation to the number of times the Pariente card can be used in order to prevent unauthorized use of the card to protect against unauthorized use.”

B) Applicable case law

It is respectfully submitted that a rejection under 35 U.S.C. § 103 requires that a combination of references disclose, either expressly or inherently, each and every element set forth in the claims, considering the claims “as a whole.” To be “inherently” described in a prior art reference, the prior art reference “must make clear that the missing descriptive matter is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill.” Inherency “may not be established by probabilities or possibilities.” The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

*Continental Can Co. USA v. Monsanto Co.*, 948 F.3d 1264 (Fed. Cir. 1991).

Meanwhile, the requirement that the claimed invention be considered “as a whole” is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection under 35 U.S.C. § 103 requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the

claimed invention, would have selected the various parts from the references and combined them in the claimed manner. In other words, the test of whether it would have been obvious to select specific teachings and combine must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Furthermore, it is well settled that “in order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992).

C) The rejection of claim 1 fails to present a *prima facie* case of obviousness

It is respectfully submitted that neither Pariente nor Renner, whether considered alone or in combination, disclose each and every element set forth in the claim as is required to maintain a rejection under 35 U.S.C. § 103. Furthermore, it is respectfully submitted that Renner fails to have any disclosure which can be said to suggest modifying Pariente to arrive at the exact invention set forth in the claim as is also required to maintain a rejection under 35 U.S.C. § 103.

In rejecting the claims it was acknowledged that Pariente fails to disclose, teach, or suggest the claimed readable media wherein the readable media has stored thereon access data that is modifiable by the remote control for the purpose of limiting use of code data (also stored on the readable media).

While it was asserted that Renner teaches an intelligent card reader in which “the card is programmed with limitations such as the number of times the card can be used or having a preprogrammed expiration date,” it is respectfully submitted that even given this interpretation of Renner (which is believed to be incorrect), the fact remains that Renner still fails to expressly or inherently disclose, teach, or suggest those claimed elements which have been acknowledged to be missing from Pariente and, as such, cannot be said to suggest modifying Pariente to arrive at the invention claimed. Specifically, like Pariente, nothing from Renner expressly or inherently describes, teaches, or suggests the desirability of providing a readable media that has stored thereon access data that is modifiable by a remote control for the purpose of limiting use of code data that is also read from the readable media by the remote control.

Turning now to Renner, Renner describes a system for limiting access to physical locations that are under the control of an intelligent card reader (“ICR”). As further described within Renner, the ICR is adapted to read a card inserted into the ICR. (Col. 11, line 17). Furthermore, Renner plainly states that the card inserted into the ICR stores nothing more than a static key value. (Col. 11, lines 17-22). Yet further, Renner plainly states that once the static key value is read from the card by the ICR, the ICR (*and not the card*) may be programmed to react to the read key value to control parking garage gates or other types of entry-inhibiting devices such as safes or file cabinets, to make access contingent on other parameters such as the time of day or day of week, or to control access to a number of times or a preprogrammed expiration date. (Col. 11, lines 30-35).

Nowhere, however, does Renner ever set forth that the ICR modifies *any* data that might be stored on the card that is insertable into the ICR. Absent this disclosure, teaching, or suggestion, it cannot be said Renner expressly discloses, teaches, or suggests the desirability of a

system in which data stored on a card is modified by a device which reads the card, e.g., a remote control, let alone for the purpose of limiting use of other data read from the card of which there is none in the system of Renner, i.e., the card of Renner only stores a key value. Similarly, since Renner discloses a system in which the ICR is programmed to do nothing more than read and react to the static key value stored on the card insertable into the ICR, it cannot be said that Renner inherently discloses, teaches, or suggests those claimed elements that are acknowledged to be missing from Pariente, i.e., make clear that the missing descriptive matter is necessarily present in the thing described and that it would be so recognized by persons of ordinary skill.

In sum, since neither Pariente nor Renner disclose, describe, teach, or suggest, either expressly or inherently, a card that has stored thereon access data that is modifiable by the reading device, i.e., remote control, for the purpose of limiting use of other data that is also stored on the smart card and read by the reading device as is set forth in the claim, the combination of Pariente and Renner cannot be said to establish a *prima facie* case of obviousness. For this reason, it is submitted that the rejection of claims 1-10 must be withdrawn.

D) The rejection of claim 1 impermissibly relies upon “non-analogous” art

It is still further respectfully submitted that Renner, which addresses the problem associated with how to limit access to physical locations, i.e., parking garages, safes, etc., is clearly non-analogous art and, therefore, not suitable for use in determining the obviousness of the invention claimed. As noted above, it is well settled that “in order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” With respect to the first criteria used to determine relevance of a

prior art reference it cannot be argued that the programmable card reading lock disclosed within Renner is in the field of remote controls. This is evidenced by, among other things, the USPTO classifications of Renner as compared to the USPTO classifications of the subject application for patent. With respect to the second criteria used to determine relevance of a prior art reference, it is submitted that the disclosure within Renner would not have commended itself to the inventor's attention in considering the problem the subject invention solves, i.e., the problem solved by the subject invention has nothing to do with using a key to limit access to physical locations via a programmable key accepting lock. Thus, for the reason that Renner is non-analogous art it is respectfully submitted that the rejection of the claims must be withdrawn. *Wang Laboratories, Inc. v. Toshiba Corp.*, 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993) (Reference was found to be in a different field of endeavor because it involved memory circuits in which modules of varying sizes may be added or replaced, whereas the claimed invention involved compact modular memories and since memory modules of the claims at issue were intended for personal computers and used dynamic random-access-memories, whereas reference SIMM was developed for use in large industrial machine controllers and only taught the use of static random-access-memories or read-only-memories.)

E) No *prima facie* case of obviousness has been presented for any of claims 2-10

It is additionally submitted that a *prima facie* case of obviousness has not been presented for any of dependent claims 2-10. In this regard, the Office Action fails to set forth where either Pariente or Renner disclose the elements set forth in these claims, considering each and every word. For example, the Office Action never asserts that either Pariente or Renner discloses,



teaches, or suggests code data stored on a readable media that is limited in use by means of access data wherein the code data specifically:

- 1) functions to allow remote control access to limited-access programming (claim 3);
- 2) functions to allow timed access to limited-access programming (claim 4);
- 3) functions to allow a predetermined number of accesses to limited-access programming (claim 5);
- 4) functions to enable access to a code stored within the remote control (claim 7);
- 5) functions to associate command codes with buttons of the remote control (claim 8); or
- 6) functions as data representative of a channel line-up of a broadcast service provider (claim 9 or claim 10).

Since the burden of presenting a *prima facie* case of obviousness with respect to any of claims 2-10 has not been met and since neither Pariente nor Renner disclose any of the elements above-noted, the rejection of at least the above-noted claims must be withdrawn.

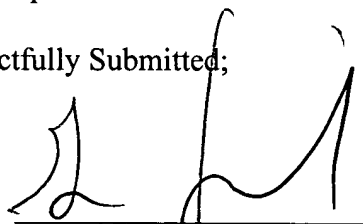
#### F) Conclusion

It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Board is respectfully requested.

Respectfully Submitted;

Date: January 12, 2006

By:



Gary R. Jarosik  
Reg. No. 35,906  
Greenberg Traurig, LLP  
77 W. Wacker Drive, Suite 2500  
Chicago, Illinois 60601  
(312) 456-8449

## VIII. CLAIMS APPENDIX

The following is a clean copy of the claims involved in the Appeal:

1. A system for programming a remote control, comprising: a readable media having electrical contacts for allowing the readable media to be releasably connected to the remote control, the readable media having stored thereon code data where the remote control is adapted to read the code data from the readable media and thereafter use the code data in connection with commanding a first home appliance to perform an operation and wherein the readable media has stored thereon access data that is modifiable by the remote control for the purpose of limiting use of the code data.
2. The system as recited in claim 1, wherein the code data functions to add codes to the remote control for use in connection with commanding a second home appliance to perform an operation.
3. The system as recited in claim 1, wherein the code data functions to allow remote control access to a limited-access program presented on the first home appliance.
4. The system as recited in claim 3, wherein the access data functions to allow timed access to the limited-access program presented on the first home appliance.
5. The system as recited in claim 3, wherein the access data functions to allow a predetermined number of accesses to the limited-access program presented on the first home appliance.

6. The system as recited in claim 1, wherein the code data functions to add a code to the remote control for use in commanding the first home appliance to perform a predetermined operation not otherwise commandable via the remote control.

7. The system as recited in claim 1, wherein the code data functions to enable access to a code stored within the remote control for use in commanding the first home appliance to perform a predetermined operation.

8. The system as recited in claim 1, wherein the code data functions to associate command codes with buttons of the remote control whereby activation of one of the buttons commands the first home appliance to access a specific program presented on the first home appliance.

9. The system as recited in claim 8, wherein the code data comprises data to enable remote control access a channel line-up of a broadcast service provider.

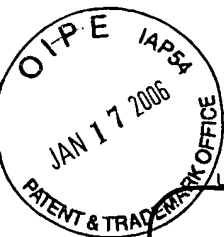
10. The system as recited in claim 9, wherein the code data reflects a change to a channel line-up of a broadcast service provider.

IX EVIDENCE APPENDIX

No evidence was submitted pursuant to Secs. 1.130, 1.131, or 1.132.

X. RELATED PROCEEDINGS APPENDIX

No decisions have been rendered by a court or the Board in any proceedings identified pursuant to paragraph (c)(1)(ii) of 37 CFR 41.37.



AF  
DAW

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

14

Application Number

10/662,263

Filing Date

09/15/2003

First Named Inventor

Patrick H. Hayes

Art Unit

2635

Examiner Name

Zimmerman, Brian A.

Attorney Docket Number

81230.38US5

### ENCLOSURES (Check all that apply)

☐

Fee Transmittal Form

☒

Fee Attached

☐

Amendment/Reply

☐

After Final

☐

Affidavits/declaration(s)

☐

Extension of Time Request

☐

Express Abandonment Request

☐

Information Disclosure Statement

☐

Certified Copy of Priority Document(s)

☐

Reply to Missing Parts/  
Incomplete Application

☐

Reply to Missing Parts  
under 37 CFR 1.52 or 1.53

☐

Drawing(s)

☐

Licensing-related Papers

☐

Petition

☐

Petition to Convert to a  
Provisional Application

☐

Power of Attorney, Revocation

☐

Change of Correspondence Address

☐

Terminal Disclaimer

☐

Request for Refund

☐

CD, Number of CD(s) \_\_\_\_\_

☐

Landscape Table on CD

☐

After Allowance Communication to TC

☐

Appeal Communication to Board  
of Appeals and Interferences

☒

Appeal Communication to TC  
(Appeal Notice, Brief, Reply Brief)

☐

Proprietary Information

☐

Status Letter

☒

Other Enclosure(s) (please identify  
below):

#### Remarks

- Appeal Brief in TRIPLICATE
- Check # 9403 in the amount of \$500.00
- return postcard

### SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Customer No. 34018 - Greenberg Traurig, LLP

Signature

Printed name

Gary R. Jarosik

Date

January 12, 2006

Reg. No.

35,906

### CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:

Signature

Typed or printed name

Vivian DeLaRosa

Date

January 12, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.